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1648



Patent  
Attorney Docket No. 012627-022

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Rolf M. FLUGEL et al.

Application No.: 09/868,502

Filing Date: February 7, 2002

Title: Foamy Virus Vectors For Expressing Foreign Genes In Mammals And The Use Thereof

Group Art Unit: 1648

Examiner: Myron G. Hill

Confirmation No.: 1264

AMENDMENT/REPLY TRANSMITTAL LETTER

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Enclosed is a reply for the above-identified patent application.

- ☐ A Petition for Extension of Time is also enclosed.
- ☐ Terminal Disclaimer(s) and the ☐ \$55.00 (2814) ☐ \$110.00 (1814) fee per Disclaimer due under 37 C.F.R. § 1.20(d) are also enclosed.
- ☐ Also enclosed is/are \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_
- ☐ Small entity status is hereby claimed.
- ☐ Applicant(s) requests continued examination under 37 C.F.R. § 1.114 and enclose the ☐ \$385.00 (2801) ☐ \$770.00 (1801) fee due under 37 C.F.R. § 1.17(e).
- ☐ Applicant(s) requests that any previously unentered after final amendments not be entered. Continued examination is requested based on the enclosed documents identified above.
- ☐ Applicant(s) previously submitted \_\_\_\_\_  
\_\_\_\_\_  
on \_\_\_\_\_,  
for which continued examination is requested.
- ☐ Applicant(s) requests suspension of action by the Office until at least \_\_\_\_\_, which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R. § 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.
- ☐ A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (1809/2809) is also enclosed.

- ☒ No additional claim fee is required.
- ☐ An additional claim fee is required, and is calculated as shown below.

| AMENDED CLAIMS   |                  |  |              |                    |                |
|--|------------------|--|--------------|--------------------|----------------|
|  | No.<br>of Claims | Highest No. of<br>Claims<br>Previously Paid<br>For | Extra Claims | Rate               | Additional Fee |
| Total Claims   |                  | MINUS =  | 0            | x \$18.00 (1202) = | \$ 0.00        |
| Independent Claims   |                  | MINUS =  | 0            | x \$86.00 (1201) = | \$ 0.00        |
| If Amendment adds multiple dependent claims, add \$290.00 (1203)                                 |                  |  |              |                    |                |
| Total Claim Amendment Fee  |                  |  |              |                    | \$ 0.00        |
| <input type="checkbox"/> Small Entity Status claimed - subtract 50% of Total Claim Amendment Fee |                  |  |              |                    | \$ 0.00        |
| <b>TOTAL ADDITIONAL CLAIM FEE DUE FOR THIS AMENDMENT</b>   |                  |  |              |                    | <b>\$ 0.00</b> |

- ☐ A check in the amount of \_\_\_\_\_ is enclosed for the fee due.
- ☐ Charge \_\_\_\_\_ to Deposit Account No. 02-4800.

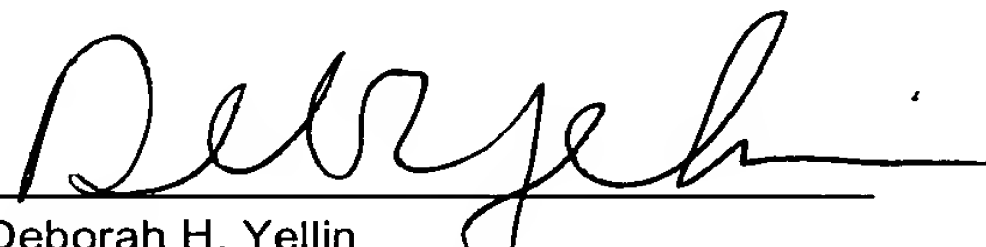
The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

P.O. Box 1404  
Alexandria, Virginia 22313-1404  
(703) 836-6620

Date: March 24, 2004

By   
Deborah H. Yellin  
Registration No. 45,904



Patent  
Attorney's Docket No. 012627-022

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

|                              |   |                         |
|------------------------------|---|-------------------------|
| In re Patent Application of  | ) |                         |
| Rolf M. FLUGEL et al.        | ) | Group Art Unit: 1648    |
| Application No.: 09/868,502  | ) | Examiner: Myron G. Hill |
| Filed: February 7, 2002      | ) | Confirmation No.: 1264  |
| For: FOAMY VIRUS VECTORS FOR | ) |                         |
| EXPRESSING FOREIGN GENES IN  | ) |                         |
| MAMMALS AND THE USE          | ) |                         |
| THEREOF                      | ) |                         |

**RESPONSE TO REQUIREMENT FOR RESTRICTION**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In complete response to the Official Action (Requirement For Restriction) mailed February 24, 2004, in regard to the subject application, Applicants elect Group I (claims 1-12, drawn to a retroviral vector), with traverse.

Applicants respectfully traverse the restriction requirement as set forth in the Office Action. Applicants respectfully submit that the inventions of Groups I-IV should properly be examined together. Applicants note that the inventions of Groups I-IV are closely related, as the retroviral vector of Group I is used in the remaining subject matter, such as the vaccinations of Group III and the methods of gene therapy of Group IV. Thus, a proper search of any of the claims should, by necessity, require a proper search of the others. Thus, Applicants submit that all of the claims can be searched simultaneously, and that a duplicative search, with possibly inconsistent results, may occur if the restriction requirement is maintained. Applicants submit that any nominal burden placed upon the Examiner to

search accordingly to determine the art relevant to Applicants' overall invention is significantly outweighed by the public's interest in not having to obtain and study many separate patents in order to have available all of the issued patent claims covering Applicants' invention.

Regardless of whether the two inventions are independent or distinct, Applicants respectfully assert that the Examiner need not have restricted the application. MPEP § 803 requires that "[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." Therefore, it is not mandatory to make a restriction requirement in all situations where it would be deemed proper.

Furthermore, Applicants note that the Examiner of the corresponding PCT international application did not determine that the claims lacked unity. In fact, the Examiner searched and examined all of the claims together in the PCT international application. The claims of the PCT application cover the same subject matter as those in the current U.S. national stage application, albeit the claims in the current application were amended to conform to U.S. claim format. To now require that the claims lack unity would contradict what was done in the corresponding international PCT application.

It is well established that if the rule and interpretation of the PTO with regards to unity of invention conflicts with the PCT, it runs afoul of Article 27 of the PCT. *Caterpillar Tractor Co. v. Commissioner of Patents and Trademarks*, 231 U.S.P.Q. 590 (E.D. Va. 1986). Article 27 of the PCT provides in part that "no national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations." *Caterpillar*

*Tractor*, 231 U.S.P.Q. at 591. Therefore, a restriction requirement based on a lack of unity would be improper.

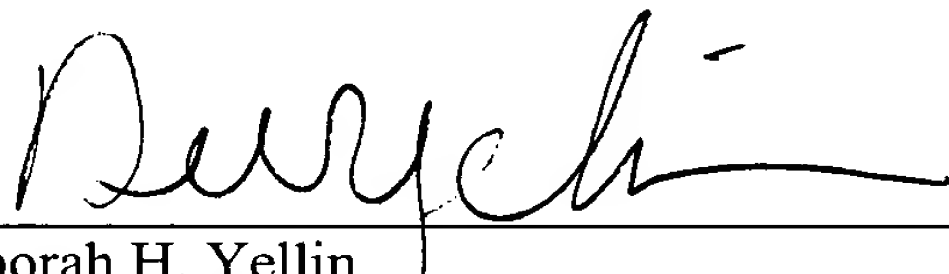
**CONCLUSION**

For at least those reasons set forth above, Applicants respectfully request withdrawal of the requirement for restriction and favorable consideration of all the claims of record on the merits. Should the Examiner have any questions regarding this application, he is invited to call the undersigned at the telephone number provided below.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: March 24, 2004

By:   
Deborah H. Yellin  
Registration No. 45,904

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